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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Joseph Arruda *et al.*

SERIAL NUMBER: 09/944,625

EXAMINER: Matthew Luu

FILING DATE: August 31, 2001

ART UNIT: 3663

FOR: CAP WITH RETRACTABLE STYLUS

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Boston, Massachusetts

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pre-Appeal Brief Request for Review

This paper is in response to the Office Action, which was designated as “final,” of October 14, 2005, in the above-identified patent application. The Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the following reasons.

Omission of Elements from the Claims in the Cited Art:

In this application, two independent claims (*i.e.*, claims 26 and 36) are presently pending. Each of the other claims depend from claim 26 and, therefore, incorporate its limitations. As explained, below, both of these claims include at least one element that clearly is missing and not suggested by the prior art in the context claimed.

A) Claim 26:

Claim 26, as amended on September 26, 2005, is reproduced, below. The reference numbers from one embodiment of the writing instrument, as illustrated in FIGS. 3(b), 4(a), and 4(b) of the subject application, are inserted into the claim to facilitate an understanding as to one example of the claimed writing instrument (though the invention is not to be understood as being unnecessarily limited to the example of these figures).

26. A writing instrument (200) for alternatively writing on a surface and for interfacing with a touch sensitive display, the writing instrument (200) comprising:

an elongated body (215) having a first end (206) having a writing tip (205) and a second end (207); and

a cap (220) having a first end having a first aperture adapted to receive the first end (206) of the elongated body (215) and also adapted to receive the second end (207) of the elongated body (215), the cap (220) also having a second end having a second aperture (221) with a retractable non-writing tip (210) mounted therein, the non-writing tip (210) being adapted for use with a touch sensitive display, wherein the second end (207) of the elongated body (215) cooperates with the cap (220) to extend the non-writing tip (210) outwardly from the second aperture (221) as the cap (220) receives the second end (207) of the elongated body (215).

(Emphasis added).

In making his novelty rejection, the Examiner equated the “rear portion 18” of the pen’s elongated body in FIG. 9 of US 5,889,512 (Moller) with the cap of Applicants’ claim 26. Further, the Examiner indicated that the rear portion 18 of Moller’s pen “receives” the second end of the grip portion 16 of the elongated body and equates this with the above highlighted text from claim 26 specifying that the cap has “a first end having a first aperture adapted to receive the first and second ends of the elongated body.” To the contrary, even if one were to equate the “grip portion 16” in Moller with the elongated body in claim 26 and also to equate the “rear portion 18” in Moller with the cap in claim 26, the aperture (through which the extension member 48 extends) in Moller is too small to accept the second end of the grip portion 16. Instead, the threads at the end of the grip portion 16 receive (or contain) the outer threads on the rear portion 18--rather than vice versa.

For the cap to have an *aperture adapted to receive* a first and second end of an elongated body, the aperture must be sized and shaped such that the first and second ends of the elongated body can enter into it. The Examiner asserted that the phrase, “adapted to,” is non-limiting. However, that assertion is inaccurate as a blanket rule. Rather, the question as to whether a

phrase of this type is limiting is determined by the context in which it is used, as explained in M.P.E.P. § 2111.04. Here, the phrase is clearly limiting because it requires a structure that can receive the first and second ends of the elongated body.

In Moller, that aperture is simply too small to accommodate the threaded end of the grip portion therein. Consequently, the aperture in Moller clearly is *not* adapted to receive the grip portion; and Moller, therefore, does not anticipate claim 26 or claims 28-32, which depend therefrom. Nor is there any suggestion or motivation in the prior art for enlarging the aperture in the rear portion of Moller to receive the grip portion therein; consequently, these claims also are non-obvious over Moller.

B) Claim 36:

Claim 36, as amended on September 26, 2005, is reproduced, below.

36. A cap for an instrument, the cap comprising:
a first end for positioning over an end of the instrument; and
a second end having an aperture, the aperture having a non-writing retractable tip mounted therein, the retractable tip being adapted for use with a touch sensitive display, *the retractable tip movable between a first normal position retracted within the second aperture* and a second extended position extending out of the second aperture.

(Emphasis added).

In making his novelty rejection, the Examiner equated the extension member 48 and cap 60 of Moller with the retractable tip in claim 36. The cap 60, however, cannot be retracted into the aperture at the end of the rear portion 18 in the apparatus of Moller. In all of the illustrations, the cap 60 has a bulbous shape having a diameter larger than that of the aperture so that the cap 60 cannot be retracted within the aperture--rather, the cap 60 will always be outside the rear portion 18. This is particularly evident in FIG. 14 of Moller, where the extension member is inserted into the rear portion as far as it will go, and where the end cap (at far right) clearly won't fit inside the rear portion.

Absent a retractable tip that can be retracted within an aperture at the end of a cap, Moller can not anticipate Applicants' claim 36. Nor is there any suggestion or motivation in the prior

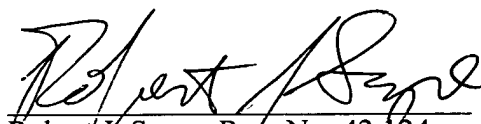
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art for making the cap in Moller retractable into the aperture; claim 36, therefore, also is non-obvious over Moller.

CONCLUSION

On the basis of the foregoing, Applicant respectfully submits that the clear absence of any disclosure or suggestion in the prior art of the above-identified elements from the claims proves a legal deficiency in the pending novelty and obviousness rejections. Accordingly, Applicant respectfully requests that the rejections under 35 U.S.C. §§102 and 103 be withdrawn.

Respectfully submitted,



Robert J. Sayre, Reg. No. 42,124
Attorney for Applicants
MINTZ, LEVIN, COHN, FERRIS,
GLOVSKY and POPEO, P.C.
Address all written correspondence to
Customer No. 30623
Tel: (617) 542-6000
Fax: (617) 542-2241